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Paper No. 7

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AUG 27 2001

In re Application of
Vilmos Keri, Irma Hogye,
Antonia Jekkel, Ilona Bagdi,
Gabor Ambrus, Attila Jakab,
Attila Andor, Lajos Deak,
Istvan Szabo, Janos Balint,
Zsuzsanna Scheidl, Etelka Deli,
Gyula Horvath, Csaba Szabo,
Ildiko Lang, Imre Szekely,
Imre Moravcsik, Vera Kovacs,
Szabolcs Matyas, Zsuzsanna Sztaray
and Laszlo Eszenyi
Application No. 09/578,587
Filed: April 19, 2000
Title: PROCESS FOR THE ISOLATION
AND PURIFICATION OF MEVINOLIN

OFFICE OF PETITIONS

DECISION REFUSING
STATUS UNDER
37 CFR 1.47(a)
and
DECISION VACATING
CERTAIN REQUIREMENTS
SET FORTH IN THE
NON-FINAL OFFICE
ACTION MAILED
JUNE 27, 2001

This is in response to the petition, filed January 16, 2001, under 37 C.F.R. §1.47(a). This decision also addresses requirements regarding the declaration for patent set forth in the non-final Office action mailed June 27, 2001.

BACKGROUND

The above-identified application was filed on April 19, 2000, as a continuation-in-part of application No. 08/659,961, filed on June 7, 1996 (now abandoned), which was a continuation of application No. 08/269,150, filed on June 30, 1994 (now abandoned). A declaration which appears to have been executed in prior application No. 08/269,150 was among the papers present in the application on filing. However, the basic statutory filing fee was not submitted. On August 10, 2000, the Office mailed applicant a "Notice to File Missing Parts of Nonprovisional Application," requiring payment of the filing fee and the late filing fee surcharge under 1.16(e).

On January 16, 2001, applicant paid the filing fee and the surcharge; and filed a declaration executed by inventors Keri, Hogye, Bagdi, Jakab, Deak, Deli, Csaba Szabo, Kovacs, Sztaray, and Eszenyi on behalf of themselves and on behalf of non-signing inventors Ilkoy,¹ Jekkel, Ambrus, Andor, Istvan Szabo, Balint, Scheidl, Horvath, Lang, Szekely, Moravcsik, and Matyas, with a petition under §1.47(a); and a request for a three-month extension to make the reply timely. Payment of the filing fee and surcharge appear to have been processed as proper and complete replies to the "Notice to File Missing Parts of Application." The application was then forwarded to Technology Center 1600 for examination.

¹ This inventor needs to be made of record.

Upon her review of the application, examiner Marx determined that the declaration and petition under §1.47(a) had not been properly considered. In an Office action mailed June 27, 2001, the examiner stated that the declaration was defective as it was not in compliance with §1.67(a); did not include proof of Mary Balint as a legal representative; and did not include an express statement of the duty of disclosure set forth in §1.56 for the period between the filing of the prior application and the national or PCT international filing date of the continuation-in-part application. The examiner then forwarded the application to the Office of Petitions for consideration of the petition under §1.47(a).

Consideration - Petition under §1.47(a)

The "Notice to File Missing Parts of Application," mailed August 10, 2000, should have also required applicant to file a newly executed declaration covering the subject matter claimed in this application². Fortunately, despite this omission, applicant timely responded with a new declaration and petition under §1.47(a). On petition, applicant asserted that rule 47 status is proper because eleven (11) of the twenty-two (22) inventors refuse to sign the new declaration. In support thereof, applicant submitted the declaration of foreign patent agent Emri Zsuzsa detailing the facts relied on to conclude that the non-signing inventors refused to join in the application.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventors cannot be reached or refuse to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition lacks items (1) and (4).

As to item (1), rule 47 applicant has not shown that the non-signing inventors by their conduct, or otherwise, refuse to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The declaration of facts of patent agent Zsuzsa states that only the declaration for patent was sent, and that it was sent to only one of the non-signing inventors, Imre Moravcsik. On renewed petition, applicant must establish that the entire application package, including specification, claims and drawings, was presented to each non-signing inventor and each inventor refused to sign. A copy of the application papers should be sent to the last known address of each non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary

² An oath or declaration from a prior nonprovisional application cannot be used to meet the requirements of §§1.51(b)(2) and 1.53(f) in a continuation-in-part application. See MPEP 602.05(a).

evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record. If appropriate, English language translations of the documentary evidence should also be submitted.

Moreover, where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Patent agent Zsuzsa's declaration suggests that he only has firsthand knowledge of inventor Moravcsik's refusal to sign. Likewise, when it is concluded by the rule 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. On request for reconsideration, applicant must be specific and fully describe the facts relied on to conclude that each inventor refuses to join in the application. Any affidavit or declaration of facts submitted must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

As to item (4), the petition does not include a statement of the last known addresses of the non-signing inventors. The renewed petition should include such statements for all non-signing inventors. Incorporation by reference to other documents in the record is not sufficient.

Accordingly, the petition under §1.47 is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the above-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted above, except that the reply may include an oath or declaration executed by the non-signing inventors. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

Consideration - Other Declaration Requirements set forth in the Non-final Office Action mailed June 27, 2001

Notwithstanding the deficiencies noted above, the declaration has been reviewed and found sufficient as to current requirements regarding proof of authority of legal representative and the duty of disclosure under §1.56. Effective September 8, 2000, §1.64(b) was amended to provide that if the person making the oath or declaration is the legal representative, the oath or declaration shall state that the person is the legal representative and shall also state the citizenship (pursuant to 35 USC 115 and 117) residence and mailing address of the legal representative. Section 1.44 was removed and reserved to eliminate the requirement that proof of the power or authority of the legal representative be recorded in the Office or filed in an application under §§1.42 or 1.43. Accordingly, the requirement set forth in the non-final Office action that applicant submit proof of Mary Balint as a legal representative is **VACATED**.

Likewise, both \$1.63(e) and \$1.56 were amended, effective November 7, 2000, eliminating the requirement for an express statement acknowledging the duty of disclosure under \$1.56 for the period between the filing of the prior application and the national or PCT international filing date of the C-I-P application. Accordingly, the examiner should no longer object to an oath or declaration in a C-I-P that does not contain this statement. Hence, the requirement that applicant include an express statement of the duty of disclosure set forth in \$1.56 for the period between the filing of the prior application and the national or PCT international filing date of the continuation-in-part application is VACATED.

CONCLUSION

Petitioner is advised that only the requirements set forth in former \$1.44 and \$1.56 specifically addressed in this decision are vacated. This decision does not otherwise impact the non-final Office action mailed June 27, 2001. **The period for reply to the non-final Office action continues to run from the mail date of that action, June 27, 2001, with extensions of time permitted under \$1.136(a).** However, the application file will remain in the Office of Petitions to await a request for reconsideration of petition under \$1.47, as the application cannot be returned to the Technology Center for examination without a proper declaration.

Further correspondence with respect to this matter, especially the filing of any Request for Reconsideration of Petition under \$1.47(a), should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

E. Sharon Willard for
Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy